

REMARKS

I. Introduction

With the addition of new claims 23 and 24, claims 10 to 24 are currently pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant notes with appreciation the acknowledgement of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

II. Information Disclosure Statement

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper, and cited references. Applicants submit herewith a Supplemental Information Disclosure Statement and PTO-1449 paper, which cites European Published Patent Application Nos. 0 857 949 and 0 800 059 and provides complete copies thereof.

III. Unity of Invention

Applicants respectfully maintain that the Office Actions to date plainly fail to establish that the unity of invention requirement has not been satisfied. As an initial matter, whether a method according to claims 15 to 21 requires a control element as recited in claims 10 to 14 and 22 is entirely irrelevant to the question of whether the unity of invention requirement is satisfied. In addition, the classification of the groups of claims and examining art units is likewise entirely irrelevant to the question of whether the unity of invention requirement is satisfied.

Unity of invention exists when there is a technical relationship among the claims involving one or more of the same or corresponding special technical features, *i.e.*, those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. There is no mention whatsoever in any Office Action to date that any consideration has been given to whether Group I, *i.e.*, claims 10 to 14 and 22, and Group II, *i.e.*, claims 15 to 21, involve one or more of the same or corresponding special technical features. Indeed, no comparison has apparently been made at all to the prior art. In this regard, the only ground of rejection raised to date is a rejection of claims 15 to 21 under 35 U.S.C. § 101, which is addressed below.

In view of the foregoing, reconsideration and withdrawal of the finding of a lack of unity of invention is respectfully requested. In any event, it is believed and respectfully submitted that rejoinder will be appropriate when claims 15 to 21 are found allowable.

IV. Rejection of Claims 15 to 21 Under 35 U.S.C. § 101

Claims 15 to 21 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicants respectfully submit that the present claims fully comply with the requirements of 35 U.S.C. § 101 for at least the following reasons.

The Office Action contends that claims 15 to 21 do not produce any tangible result. As an initial matter, Applicants respectfully disagree with the contention that for claimed subject matter to meet the requirements of 35 U.S.C. § 101, “it would need to output to a user, displayed to a user, stored for later use, or used in any tangible manner.” Applicants respectfully request authority for the foregoing proposition.

Claims 15 to 21 plainly recite a method, which is squarely within one of the four categories set forth in 35 U.S.C. § 101. Furthermore, a sufficient transformation or reduction of an article to a different state or thing is set forth in claim 15. In this regard, claim 15 recites, *e.g.*, “transmitting, by a measurement device to a second device via a data-transmission device, a but having a constant level to signal a fault-free operation of the measuring device” and “electrically contacting a signal-monitoring circuit of the measuring device with a test-potential source.” In light of the foregoing, no further inquiry with respect to whether the present claims satisfy the requirements of 35 U.S.C. § 101 is necessary, since the claims plainly meet the requirements of 35 U.S.C. § 101. *See, e.g.*, “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility,” § IV.C.2.a (“The examiner first shall review the claim and determine if it provides a transformation or reduction of an article to a different state or thing. If the examiner finds such a transformation or reduction, the examiner *shall end the inquiry and find that the claim meets the statutory requirement of 35 U.S.C. § 101.*” (emphasis added)).

In view of the foregoing, withdrawal of this rejection is respectfully requested.

V. New Claims 23 and 24

New claims 23 and 24 have been added herein. It is respectfully submitted that claims 23 and 24 do not add any new matter and are fully supported by the present application, including the Specification. Since claims 23 and 24 depend from claim 15, it is respectfully submitted that claims 23 and 24 are patentable for at least the reasons more fully set forth above.

VI. Conclusion

In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

Dated: October 12, 2006 By: Cliff A. Ulrich
Clifford A. Ulrich
Reg. No. 42,194

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO 26646